

REMARKS

New claim 32 has been added. Support for this claim exists throughout the present specification, including page 7, lines 5-8.

Claims 1-32 are currently pending, although claims 18-25 and 31 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants intend to seek appropriate rejoinder of withdrawn claims pursuant to MPEP 821.04.

The Office Action rejected claims 1-6, 10-12 and 20-43 under 35 U.S.C. §103 as obvious over U.S. patent 6,123,952 ("Lagrange") in view of PCT patent application publication no. WO 99/31081 ("Clark"). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

Clark and Lagrange are not properly combinable. Clark's dyes are reversible chromatic compounds given the "rapid fading" associated with Clark's dyes. (See, page 3, 1st paragraph). Clark seeks such rapid reversibility of his dyes -- it is a necessary part of his "invention." In stark contrast, Lagrange's compositions contain only irreversible photochromic compounds. In fact, Lagrange specifically excludes reversible photochromic compounds from his compositions. (See, col. 2, lines 59-62). Given these disclosures, one skilled in the art would not have been motivated to place one of Lagrange's irreversible dyes into Clark's compositions which require the presence of reversible dyes. To make such a substitution would render Clark's compositions unsuitable for their intended purpose. Thus, rather than suggest the claimed invention, these references actually teach away from it.

Under such circumstances, Clark and Lagrange are not properly combinable, and cannot form the basis for a rejection under 35 U.S.C. §103.

For at least this reason, Applicants respectfully submit that the §103 rejection should be reconsidered and withdrawn.

Furthermore, with respect to new claim 32, Clark neither teaches nor suggests dissolving the required dye in the oily phase. Rather, Clark teaches away from such dissolution, stating that his dyes are incorporated into polymeric materials. (See, page 5, 2nd and 3rd paragraphs).

For this reason as well, Applicants respectfully submit that the §103 rejection is inapplicable to claim 32.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejection.

The Office Action also rejected claims 1, 3-9, 11-17 and 26-30 under 35 U.S.C. §112, second paragraph, as being indefinite. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The Office Action's interpretation of the pending claims is correct R7 and R'2 can be at any location of the structure, and an apolar oil is a non-polar oil.

In view of these clarifying remarks, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §112.

Finally, the Office Action rejected the pending claims as obvious under the judicially created doctrine of obviousness type double patenting over the claims in U.S. patent application serial nos. 10/687,645 and 10/687,632. Although Applicants disagree with this

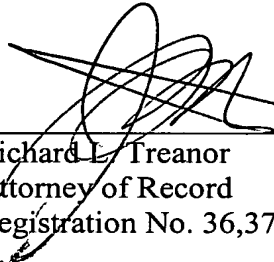
Application No. 10/687,581
Response to Office Action dated May 17, 2007

rejection, solely to expedite prosecution in this case, Applicants submit herewith a Terminal Disclaimer over both the '645 and '632 applications. Applicants respectfully submit that the Terminal Disclaimer renders moot the double patenting rejections and, accordingly, that these rejections should be reconsidered and withdrawn.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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